

### Remarks

This amendment is responsive to the final Office Action mailed February 11, 2003. On July 11, 2003, applicant filed a Notice of Appeal from that Office Action. Rather than pursuing the appeal, however, applicant has added new claims, as set forth above, and also submits the accompanying declarations of Stanley C. Johnson, Ken Caylor, and Bill Sanregret, which support nonobviousness of the invention.

Claims 24-34, which were rejected in the last Office Action, remain pending in this application. Applicant respectfully traverses that rejection.

First, the Examiner has stated that Talbot *et al.* discloses “treated paper substantially covering and adhered to all the front surface, the side surfaces, and at least a portion of the rear surface adjacent at least one of the edge surfaces (figure 1 number 27, 31, and 35) . . .” February 11, 2003 Office Action, p. 2. Talbot *et al.* does not disclose treated paper; rather, it discloses a veneer 22. A veneer is “a thin surface layer, as of finely grained wood, glued to a base of inferior material.” *The American Heritage Dictionary of the English Language, Third Edition* (3<sup>rd</sup> ed. 1996). As noted in Talbot *et al.* at column 4, line 33, the veneer is subject to cracking or checking. This is so because it is a thin piece of wood that is folded around the substrate corners.

Applicant’s invention, however, is directed to a treated paper that substantially covers and adheres to at least the front surfaces and the side surfaces. Paper is “a material made of cellulose pulp, derived mainly from wood, rags, and certain grasses, processed into flexible sheets or rolls by deposit from an aqueous suspension, and used chiefly for writing, printing, drawing, wrapping, and covering walls.” *The American Heritage Dictionary of the English Language, Third Edition* (3<sup>rd</sup> ed. 1996).

This mistake is reflected again in the Examiner’s statement on page 4 of the Office Action that it would have been obvious to provide Talbot *et al.* with a laminated veneer lumber substrate to save costs. Even if this is so, it does not result in the claimed invention which, as described above, is directed to treated paper—rather than veneer—wrapped around a substrate.

In addition to the foregoing argument, applicant requests that the Examiner consider evidence of nonobviousness provided in the accompanying three declarations. These declarations establish that the claimed invention satisfied a long-felt need that was recognized, persistent, and not solved by others. The Declaration of Stanley C. Johnson under 37 CFR 1.132 (Johnson Decl.) establishes that only two products were known that

utilized a laminated veneer lumber (LVL) substrate having paper applied to a face surface and sanded and filled edges. Johnson Decl. ¶ 3. One was made by the assignee of the present application and the other was made pursuant to the Hoffman '688 patent cited by the Examiner in this application. The Hoffman '688 patent itself, which was filed on March 17, 1989, recognized the problems associated with using laminated wood products as exterior trim, namely, "failure to give the appearance that the trim was a solid wood product, particularly as to the edges . . . This disadvantage when considered along with the fact that the plywood trim from a maintenance standard was no better, if not worse, than the solid wood trims led to a rejection of the plywood trim product." Hoffman, Col. 1, line 34 *et seq.* Hoffman therefore recognized both the maintenance problems and the appearance problems addressed by the present invention.

Although Hoffman purports to be a solution to both the maintenance and appearance problems, the old PWL product, which uses substantially the same general approach as Hoffman (i.e., sanded and filled edges), demonstrates that while it may have provided an improvement over a raw laminated veneer lumber edge, there were still abundant problems both with appearance and maintenance issues. The problems associated with the old PWL product are detailed in the form of complaints, a technical note issued by PWL, epoxy repair kits, and claims resolved. Johnson Decl. ¶¶ 5-8. These can also be seen in the photos of the old and new products and the related description of the degradation. Johnson Decl. ¶¶ 9-10.

Paragraphs 12-17 of the Johnson Declaration provide annual summaries of PWL's efforts to address these problems.

Finally, applicant's invention has already been copied. Johnson Decl. ¶ 18. For many years, there were only two LVL products along the lines of the old PWL product. Johnson Decl. ¶ 3. Applicant infers that the extensive problems associated with this type of product deterred copiers from entering the market. The new product, however, has already drawn a copier, which is evidence of nonobviousness. *Jones v. Hardy*, 727 F.2d 1524 (Fed. Cir. 1984).

The Declarations of Ken Caylor and Bill Sanregret, who is employed by a customer of PWL, further substantiate the problems associated with the old product, the resistance in the market to accepting it, and the desire for and ready acceptance of the new product in the market. Mr. Caylor's Declaration includes, as an exhibit, an e-mail from a PWL customer that epitomizes the resistance to the old PWL product.

Applicant requests reexamination and reconsideration of claims 24-34 in view of the above argument and the accompanying declarations supporting nonobviousness. In addition,

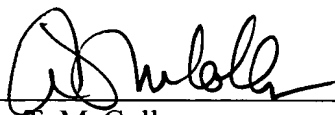
new claims 35 and 36 further define the edge surfaces. These further limitations are presented for the first time. The present claims that are narrower than in the last office action and are therefore allowable, especially in view of the accompanying declarations.

Applicant also presents new claims 37-43 that are narrower in scope, in some respects, than any of the claims presented so far. Claim 37 is broader in the sense that it defines the invention as substantially covering and adhered to all of the front surface and the side surfaces while dependent claim 38 adds the limitation that it adheres to at least a portion of the rear surface adjacent both of the edge surfaces. New claims 42 and 43 are similar to new claims 35 and 36, respectively, and are equally patentable.

For the foregoing reasons, reconsideration and allowance of claims 24-43 of the application is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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